

REMARKS/ARGUMENTS

In this Amendment After Final (“Amendment”), Applicant proposes to amend the specification, as discussed below. Applicant also proposes to amend claim 1 to recite “wherein the second part includes a material that is designed to rupture upon ejaculation of the second person” in order to better define the claimed invention. Additionally, Applicant also proposes to amend claims 1, 3, and 4 to improve clarity. No new matter is introduced.

Prior to entry of the Amendment, claims 1-8 were pending in the application. After entry of the Amendment, claims 1-8 remain pending in the application.

In the Final Office Action, the Examiner objected to the specification; rejected claim 1 under 35 U.S.C. § 112, ¶ 1; rejected claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,298,853 B1 to Blake (“Blake”); rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Blake; and rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Blake in view of U.S. Patent No. 4,955,392 to Sorkin (“Sorkin”).

Objection to the Specification

Applicant notes that originally filed claim 1 recited: “A device for preventing transmission of body fluids between two persons, at least one of whom is male, during sexual relations, said device is formed of an elastic material and said device has an inner side (3), at least a part of which is coated with a glue provided to fix said device to the man’s sexual organ, characterized in that at least a second part of said device consists of a material which is provided to rupture upon ejaculation” (emphasis added). As a result, the language of amended claim 1 is not new matter.

Additionally, Applicant proposes to amend the specification to add the following language that parallels the recitations of originally filed claim 1: “The device 1 or device 7 may

prevent transmission of body fluids between two persons, at least one of whom is male, during sexual relations. The device 1 or device 7 is formed of elastic material and has an inner side, at least a part of which is coated with glue provided to fix the device to the man's sexual organ. At least a second part of the device 1 or device 7 includes a material that is provided to rupture upon ejaculation."

Applicant submits that this amendment obviates the Examiner's objection to the specification.

Rejection Under 35 U.S.C. § 112, ¶ 1

As discussed above, Applicant proposes to amend the specification to add the following language that parallels the recitations of originally filed claim 1: "The device 1 or device 7 may prevent transmission of body fluids between two persons, at least one of whom is male, during sexual relations. The device 1 or device 7 is formed of elastic material and has an inner side, at least a part of which is coated with glue provided to fix the device to the man's sexual organ. At least a second part of the device 1 or device 7 includes a material that is provided to rupture upon ejaculation."

Additionally, Applicant notes that originally filed claim 2 recited: "The device as claimed in claim 1, wherein said second part comprises a first, stiffer part, provided to at least partially be situated in the man's spermatic duct, and a second, more brittle part provided to burst upon ejaculation, thereby enabling the man's seminal fluid to flow freely through said device" (emphasis added). Thus, because the second part is disclosed as comprising the stiffer portion and the more brittle portion, Applicant submits that the recitations of amended claim 1 ("wherein the second part includes a material that is designed to rupture upon ejaculation of the second person") and claim 2 ("wherein the second part comprises", "a stiffer portion designed to be at

least partially disposed in the urethra of the sexual organ of the second person,” and “a more brittle portion designed to burst upon the ejaculation of the second person, thereby enabling seminal fluid of the second person to flow through the device”) are consistent with each other.

Applicant submits that this amendment and discussion obviates the Examiner’s rejection of claim 1 under 35 U.S.C. § 112, ¶ 1.

Rejection Under 35 U.S.C. § 102(b)

Independent claim 1, as amended, recites, inter alia: “wherein at least a portion of the inner side is coated with glue to fix the device to the sexual organ of the second person” and “wherein the second part includes a material that is designed to rupture upon ejaculation of the second person.”

Applicant submits that Blake does not disclose using glue to fix its condom to a penis. On the contrary, viscous layer 29 of Blake “is not an impediment to the positive interior pressure of the ejaculation.” Blake, c. 8/11. 16-17. Thus, as shown in FIGs. 3 and 4 of Blake, viscous layer 29 does not prevent the condom from separating from the penis under the positive interior pressure of an ejaculation. As a result, layer 29 of Blake may be viscous, but it is not glue.

Applicant also submits that Blake does not disclose its condom as including “a material that is designed to rupture upon ejaculation.” On the contrary, Blake discloses at least two seminal fluid reservoirs 14 and 24, indicating that the condom material of Blake is designed not to rupture upon ejaculation. For example, FIGs. 3, 4, and 6 of Blake all show a condom “after use,” as discussed under the heading “Brief Description of the Drawings.” In each of these drawings, the seminal fluid reservoir 14 or 24 is expanded, but intact. Thus, the condom of Blake is not “designed to rupture.”

Additionally, the Examiner's disingenuous statement that FIG. 4 shows seminal fluid reservoir 14 in "its burstable state" (Office Action, p. 5) serves to further demonstrate that Blake does not anticipate claim 1. Theoretically, any condom can burst. However, the question here is not whether the condom of Blake can burst, but whether the condom of Blake is designed to burst. And the answer, as Blake makes clear, is no.

Other support for the condom in Blake not being designed to burst includes, but is not limited to: "effective resistance to accidental displacement as well as breakage" Blake, c. 4/l. 8-9; "retention of seminal fluid is facilitated by an expansible reservoir" Id., c. 5/l. 8-9; "retention of seminal fluid is facilitated by an expansible reservoir" Id., c. 5/l. 22-23; and "retention of seminal fluid resulting from ejaculation" Id., c. 8/l. 3.

Therefore, because Blake does not disclose, either expressly or inherently, every element set forth in claim 1, Applicant submits that Blake does not anticipate claim 1 under 35 U.S.C. § 102(b).

Applicant further submits that Blake does not anticipate any of dependent claims 2-8 under 35 U.S.C. § 102(b), at least for the same reasons that Blake does not anticipate claim 1.

Rejection Under 35 U.S.C. § 103(a)

As discussed above, Blake does not disclose, either expressly or inherently, every element set forth in claim 1. For similar reasons, Applicant further submits that Blake does not teach or suggest every claim limitation in claim 1. Nor does Sorkin overcome the deficiencies of Blake discussed above. For at least these reasons, Applicant submits that claim 1 is patentable over any proper combination of Blake, Sorkin, and the other art of record under 35 U.S.C. § 103(a).

Applicant further submits that dependent claims 2-8 are patentable over any proper combination of Blake, Sorkin, and the other art of record under 35 U.S.C. § 103(a), at least for the same reasons that claim 1 is patentable over any proper combination of Blake, Sorkin, and the other art of record.

Request for Reconsideration and Allowance

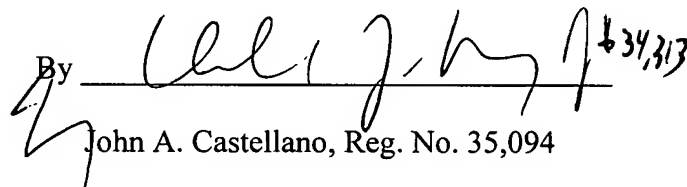
Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of each of claims 1-8 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Director of the U.S. Patent and Trademark Office is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; in particular, extension of time fees.

Respectfully submitted,

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